

REMARKS

Reconsideration and allowance of the subject application are respectfully requested.

Claims 1-35 stand rejected under 35 U.S.C. 103 as being unpatentable in view of the Winzip helpfile document. This rejection is respectfully traversed.

There are several known techniques for storing a large number of documents in a database. A single document in the database may contain references to other documents, graphics files, and/or sound files of the same database or even to a separate database. An example of such a document is an HTML document widely used in the Internet/World Wide Web (WWW) environment. Typically, a database of HTML documents is stored on a web server connected to the World Wide Web. A user can browse documents stored in the database at the web server using a web browser. Typically, the web server receives a uniform resource locator (URL) request from the web browser, decodes URL, handles the document files, and sends the requested files to the web browser. It is also possible to browse documents locally in a local file system in a stand-alone data processing device that is not connected to the World Wide Web. In this case, the document address corresponding to a local file path is given to the local file system which then retrieves the file for the browser.

These conventional arrangements are problematic in a situation where a document database has been configured so that a set of multiple documents is stored as a single file. Typically, the browser can only access separate documents located at a given URL address. But in a single file database structure, those documents stored in the single file can not be accessed in this traditional fashion.

Nevertheless, there is a significant advantage to structuring a database that includes thousands of individual documents by storing them as a single file. A single file can be managed

much more easily than thousands of separate files, some of which may be of different file types. Moreover, the single file is more readily assigned a product identity and a version identifier, facilitating guarantee of the quality of the information contained in the database through proper version handling.

Each of the multiple documents in a single file database typically contains links to other documents in that database. This creates a problem if it is desired to make the database transferable to different locations. In other words, the document links must be defined and handled so that a location-independent database can be achieved. Moreover, it would be advantageous if the single file database could be defined so that the same database management could be used in a network context (the database could be copied to any network server), and a local file system in a stand-alone data processor (the database could be copied to any file path in the file system).

The present invention solves these problems and achieves these desirable objectives by storing the multiple documents in a single file database using a specialized protocol. A non-limiting example of this single file database protocol is set forth in the detailed description starting on page 11 and is referred to as 'edw'. But the browser does not understand a specialized, single file database syntax. Accordingly, the references in the documents (e.g., URL's) must be transformed before a document in the database can be provided to the browser for display. This is true for a network server application and for a stand-alone data processor application.

The Winzip helpfile document lacks multiple features recited in the independent claims. It allows multiple files to be compressed and stored as a single archive file called a zip file. Those files can also be extracted and decompressed using an unzip operation. The step by step

example the Examiner relies on in pages 6-8 describes creating two simple text document files one.txt and two.txt, saving them to a directory c:\foo, and creating a zip file c:\foo/test.zip to archive those files. Winzip allows viewing the files simply by double clicking on the filename or by performing an extract operation.

Regarding claims 1 and 12, the Examiner is presumably construing the zip file as the claimed database and the zip file c:\foo/test.zip as the claimed single file. But how can a zip file be construed as a database? Although it is possible that a zip file may be retrieved from a database, that is not described in the Winzip helpfile document. But if it were, then there would not be any teaching of retrieving the one document (not a zip file) from the database in response to a request for that document (not for a zip file).

The Examiner also fails to point out where the Winzip helpfile document describes that a browser retrieves the document. But assuming there is some program that can be construed as a browser, Applicants find no teaching of any one of the two document files one.txt and two.txt stored in the zip file "containing links" to other files or any teaching of "scanning the retrieved document to identify said links." Where in the text of the one.txt and two.txt files, i.e., "this is the first file" and "this is the second file" (see pages 6 and 7), are there links to other documents? Where does the Winzip helpfile document describe scanning either document for links?

To contend that such links "could be" inserted into the two documents and that the two documents "could be" scanned for those links is impermissible hindsight. The standard for obviousness is not feasibility of doing something. There must be some express motivation in the prior art that suggests the desirability of doing it. See *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 (Fed. Cir. 2000).

The Examiner's contentions regarding "transforming the links into a format which is recognizable by the document browser" are untenable. First, NOTEPAD is not a browser. Second, NOTEPAD simply opens and provides immediate access to the text. There is no link transformation needed and none is performed. Indeed, there are no links to be transformed in the two documents described in the Winzip helpfile document. And Winzip merely decompresses the document file, but that no one skilled in the art would view decompression of a file as transforming document links into a format recognizable by a browser. Again, the the Winzip helpfile document does not even describe a browser; nor does it describe NOTEPAD as looking for or needing to recognize any document links.

The Examiner also fails to identify where the Winzip helpfile document describes the "transmitting" step of claim 1. The rejections of claim 3, 4, 13 and 20 are improper for similar reasons. In addition, there is no teaching in the Winzip helpfile document of "dynamically transforming the references of said retrieved document from a single file database syntax to a form said browser is capable of understanding" (quoted from claim 3).

There is certainly no recognition in the Winzip helpfile document of the problems of using such a single file database when documents are retrieved by web browsers. The Federal Circuit *requires* consideration of the problem confronted by the inventor in determining whether it would have been obvious to combine references in order to solve that problem. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 935 (Fed. Cir. 1990). Indeed, the Examiner must show reasons why one of ordinary skill in the art, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. See *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

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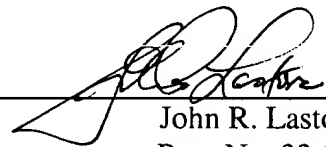
The Examiner fails to show that the Winzip helpfile document recognizes or confronts the same problem as the instant inventors. Absent that recognition, it is clear that the Examiner's attempted combination lacks the requisite motivation. The *Rouffet* Court warned against "rejecting patents solely by finding prior art corollaries for the claimed elements" because that would "permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art." *In re Rouffet*, 149 F.3d at 1357. That approach was found by the Federal Circuit to be "an illogical and inappropriate process by which to determine patentability." *Sensonics v. Aerosonic Corp.*, 85 F.3d 1566, 1570 (Fed. Cir. 1996).

The application is now in condition for allowance. An early notice to that effect is earnestly solicited.

Respectfully submitted,

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